



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/397,959

09/17/1999

KARL ERIK STAHL

927.1003

9455

21171 7590 11/24/2009

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

DUONG, DUC T

ART UNIT

PAPER NUMBER

2467

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/397,959	STAHL, KARL ERIK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Duc T. Duong	2467	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-24 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-32 is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 14-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al (US Patent 7,280,530 B2).

Regarding to claims 14 and 17, Chang discloses a system 2 for telecommunication utilizing both a circuit switched telecommunication network 16 and a packet based telecommunication network 18 (fig. 1 col. 10 lines 30-51), comprising multiple gateway telecommunication devices 4-8 (fig. 1) each having a first port (connection from PBX 34 to CO1) to connect said device to a circuit switched telecommunication network (fig. 2); a second port (connection from router 32 to IP network 18) to connect said device to a packet based telecommunication network (fig.

Art Unit: 2467

2); means 58 for initiating and receiving (fig. 3 col. 13 lines 54-63) calls for a user located in a home or office location where said device is also located (col. 7 lines 18-54); means 73 for said user to interface with said device without using a telecommunication network (fig. 3 col. 15 lines 1-13); means 50 in said device for executing requests from said user to initiate calls to parties on the circuit switched network or the packet based telecommunication network (fig. 3 col. 13 lines 54-63); and a single channel gateway means 58 (fig. 3 col. 13 lines 54-63) in said device 126 for establishing a path between said first port 174 and said second port 162 inside said device in response to a request from a server 26 on the packet based telecommunication network that is separate from a calling device 38 that a caller at a remote location is using, and the server acting on behalf of a caller 38 at a remote location (fig. 6-7 col. 29 lines 18-36); means for in response to said request connecting the second port 162 directly to the caller telephone 38 via packet based network (fig. 6-7 col. 29 lines 18-26), whereby the gateway telecommunication device can serve as part of a distributed gateway system between said packet based telecommunication network and said circuit switched telecommunication network for said caller (fig. 3A col. 11 lines 62-66) and whereby the device increases the capacity of said distributed gateway system (col. 7 lines 33-48).

Regarding to claim 15, Chang discloses a third port 73 to connect a conventional telephone apparatus 74 via said device to said first port (fig. 3 col. 15 lines 1-13).

Regarding to claim 16, Chang discloses a mechanism to automatically connect said third port to directly to said first port in the event of a power failure (col. 5 lines 46-49).

Regarding to claim 18, Chang discloses gateway location servers P1-6' connected to said packet based telecommunication network, said gateway location servers being adapted to receive a request from a first gateway telecommunication device connected to said packet based telecommunication network for telecommunication with a specified telephone apparatus on said circuit switched telecommunication network, and further being programmed to select a second of said gateway telecommunication devices to serve as a gateway between said networks for said requested connection, and to forward said request to said second gateway telecommunication device via said packet based telecommunication network (fig. 3A col. 12 lines 3-38).

Regarding to claims 19 and 20, Chang discloses the packet based telecommunication network is the Internet (col. 10 lines 50-51).

Regarding to claims 21, 23, and 24, Chang discloses each of said gateway telecommunication devices includes means for registering with said gateway location servers the availability of said device to act as a gateway between said packet based network and said circuit switched network (col. 17 lines 44-62).

Regarding to claim 22, Chang discloses each of said registered gateway telecommunication devices includes means for automatically notifying said gateway

Art Unit: 2467

location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network (col. 47 line 66-col. 48 line 2).

***Allowable Subject Matter***

3. Claims 27-32 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or make obvious the steps or means for **“a gateway location server connected to said packet based telecommunication network having information of the location of said gateway telecommunication devices, said gateway location server being adapted to receive a request from a caller anywhere on said packet based telecommunication network for telecommunication with a specified telephone apparatus on said circuit switched telecommunication network, and further being programmed to select one of said gateway telecommunication devices to serve as a gateway between said networks for said requested connection, and to forward said request to said one gateway telecommunication device via said packet based telecommunication network”**, when such gateway location server is considered within the specific structure of the device recited in claim 27.

***Response to Arguments***

4. Applicant's arguments filed July 15, 2009 have been fully considered but they are not persuasive. Regarding to applicant's argument on page 9 of the Remarks, Chang fails to teach for “means for responding to said request by connecting said second port

Art Unit: 2467

directly to said caller at the remote location via the packet based telecommunication network". In response, the examiner would like to direct applicant's attention to fig. 6-7 col. 29 lines 18-28. Herein, Chang discloses in response to a request from said caller gateway server 26, the called gateway server 126 connecting the second port 162 directly to the caller telephone 38 via caller gateway server 26. While the examiner agreed with applicant that though the interpretation "connecting ...directly" in the citation involved the connection of called gateway server 26, Chang still anticipate the claimed limitation for the following reason. As cited in applicant's Remarks, the claimed limitation is support in fig. 1 page 9 line 11-page 10 line 1 of the specification. Herein, the specification teach of in response of a request from the called gateway location server 300'", the gateway telephone 200'" (called gateway server 126) connecting the second port directly to said caller 160'/170/180 (called telephone 38) at the remote location via the gateway telephone 200' (caller gateway server 26). Thus, the term "connecting..directly" in the claim mean a direct connection between parties would involve two or more gateway telephones connecting to one another, which Chang anticipated. Based on the reason set forth here the rejections are maintained.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2467

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is (571)272-3122. The examiner can normally be reached on M-F (9:00 AM-6:00 PM).

Art Unit: 2467

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on 571-272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. T. D./

Examiner, Art Unit 2467

/Pankaj Kumar/

Supervisory Patent Examiner, Art Unit 2467